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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,426	06/28/2004	Akihito Komatsu	594.539USWO	9300

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EXAMINER	
KOSLOW, CAROL M	
ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/500,426	KOMATSU ET AL.	
	Examiner	Art Unit	
	C. Melissa Koslow	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-40 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-40 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 28 June 2004 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

In view of the papers filed 5 December 2005, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by the addition of Shigeru Uzawa.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the PTO PALM data to reflect the inventorship as corrected.

JP 62-145713; JP-62-14514 and JP 62-14515, cited in the information disclosure statement of 18 October 2004, have been considered with respect to the explanation in the specification.

JP 59-15374 and JP 63-14862, cited in the information disclosure statement of 18 October 2004, have been considered with respect to the explanation in the specification and the supplied English abstract.

JP 1-143315, cited in the information disclosure statement of 18 October 2004, has been considered with respect to the explanation in the search report and the supplied English.

JP 2000-173872, cited in the information disclosure statement of 18 October 2004, has been considered with respect to the explanation in the specification and the provided partial English translation.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Reference number 19.

The drawings are objected to because there is a discrepancy between what is shown in the figure and what is described in the specification. Number 7 in figure 1 implies it is the laminate of the dielectric film formed on the anode foil. Page 21, lines 26-33 imply laminate 7 is a composed of the coated anode foil, the separator and the aluminum cathode foil.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The disclosure is objected to because of the following informalities: The formula for phenol, on page 12, line 29 is incorrect. It should be "C_6H_5OH". The wording on page 12 implies the examples in lines 31-37 and on page 13, lines 1-8 should be limited to compounds having contain carbon-carbon or carbon-nitrogen π bonds, but the examples also include compounds

having carbon-oxygen π bonds, such as p-formylbenzoic acid. Appropriate correction is required.

Claims 12, 19 and 32 are objected to because of the following informalities: The phrase "diacetate on their" in claims 12 and 32 should be "diacetate or their". In claims 19, "electrolyte surface" should be "electrode surface". Appropriate correction is required.

The narrow compounds in the claims after the terms "such as" and "like" have been given no patentable weight. This is because the compounds are examples of the broad term and claims are given their broadest interpretation. Applicants may add dependent or independent claims directed to the above narrow phrase or range.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The Examiner was unable to find the claimed amount of carboxylic acid of claim 6 in the specification. Applicants can either point out where it is located or insert it into the specification to overcome this objection.

Claims 1-3, 5, 7-9, 12-16, 25, 27-29 and 32-34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Page 5, lines 33 through page 6, line 5, page 10, lines 18-22 and page 12, lines 9-19 all indicate the electrolyte solution must contain an electrolyte selected from the group of carboxylic acid, inorganic acids and their respective salts. The electrolyte solution of claims 1-3, 7-9, 12-16, 25, 27-29 and 32-34 do not require the presence of an electrolyte selected from the group of

carboxylic acid, inorganic acids and their respective salts. This discrepancy as to the composition of the electrolyte solution needs to be corrected.

Page 12, lines 1-18 teach the amount or concentration of inorganic acid present in the electrolyte when both an carboxylic acid and inorganic acid are present is 0.1-15 wt%, based on the total weight of the electrolyte. Claim 5 teaches teach the amount or concentration of inorganic acid present in the electrolyte solution is 0.1-15 wt%. The amount of inorganic acid in the electrolyte, which is the blend of the acids, is different from the amount in the electrolyte solution, which is composed of water, and organic solvent, an electrolyte and the unsaturated compound. This discrepancy as to the amount of the inorganic acid needs to be corrected.

Claims 10, 11, 17-24, 30, 31 and 35-40 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10, 11, 30 and 31 recites the limitation "the electrolyte". There is insufficient antecedent basis for this limitation in the claim or in the claims from which they depend. Claims 4 and 26 teach the solutions of claims 1 and 2 contain an electrolyte. Thus it appears claims 10 and 11 should depend from claim 4 and claims 30 and 31 should depend from claim 26.

Claims 17-24 and 35-40 are indefinite since they teach the compound is not present in the solution, as required by claims 14 and 15. The phrase "electrolyte solution comprising...and by including therein" indicates the compound is present in the solution. Thus it appears claims 17-25 and 35-40 are improperly depend on claims 14 and 15 since they are to different embodiments than that of claims 14 and 15. If these claims are rewritten in independent from, they may be subject to a restriction requirement, based on original presentation.

Claims 17-24 and 35-40 are also indefinite since it is unclear if the contact between the electrode and separator with the electrolyte solution, which naturally occurs in an electrolytic capacitor and implied by the second process of claims 19 and 22, inherently produces the claimed capacitor where the compound is on the electrode surface and in the separator. If it is inherent, then claims 17-25 and 35-40 are not improperly depend on claims 14 and 15.

Finally, claims 35 and 37 are improperly dependent on claim 15 since the amount of water and organic solvent in these claims is broader in scope that of the amounts of claim 15. Claim 15 teaches the solvent for the electrolyte solution is composed of 15-80 wt% organic solvent and 85-20 wt% water. Claims 35 and 37 teach the solvent for the electrolyte solution is composed of 10-80 wt% organic solvent and 90-20 wt% water.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 8-15, 17-26, 28-33 and 35-40 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 6,307,732.

This reference teaches an aluminum electrolytic capacitor where the electrodes and separator are immersed in an electrolyte solution comprising 35 wt% water, 65 wt% ethylene glycol (a protic polar organic solvent), 12 wt% ammonium adipate, as the electrolyte, 1 wt% ammonium hypophosphite (which reads upon the claimed inorganic salt), p-nitrobenzoate (a nitrocompound) and 7 wt% of an ammonium alkane dicarboxylate, where the alkane is octane or decane (examples). The ammonium alkane dicarboxylate is a compound having an unsaturated bond-containing chain which can undergo hydrogen addition. The taught amounts all fall within the claimed ranges. Since the electrodes and separator are immersed in an electrolyte solution, which is the second process of claims 19 and 22, the ammonium alkane dicarboxylate must be on the electrode surface and in the separator, absent any showing to the contrary. Page 21, lines 1-7 implies that if the amount of compound having an unsaturated bond-containing chain which can undergo hydrogen addition in the electrolyte solution is within the claimed range of 0.1-10 wt%, then the amount on the electrodes and in the separator are within the claimed ranges. Therefore, one of ordinary skill in the art would expect the amount of ammonium alkane dicarboxylate on the electrode and in the separator to be within the claimed ranges since the amount of dicarboxylate is within the claimed range. The reference teaches the claimed solutions and capacitors.

Claims 1-6, 8-15, 17-26, 28-33 and 35-40 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 6,288,889.

This reference teaches an aluminum electrolytic capacitor where the electrodes and separator are immersed in an electrolyte solution comprising 20-80 wt% water, 80-20 wt% of a organic solvent, which is protic or aprotic, an electrolyte of 3-30 wt% of a carboxylic acid and/or

0.1-15 wt% of a inorganic acid, at least one compound selected from the group consisting of saccharides, a nitro compound, gluconic acids and/or gluconic lactone and hydroxybenzyl alcohols and/or L-glutamic acid diacetate or its salts and a tetraacetic acid chelate, which is a compound having an unsaturated bond-containing chain which can undergo hydrogen addition. The examples teach the amount of chelate can be 0.4 wt%. The taught amounts all fall within the claimed ranges. Since the electrodes and separator are immersed in an electrolyte solution, which is the second process of claims 19 and 22, the exemplified tetraacetic acid chelates must be on the electrode surface and in the separator, absent any showing to the contrary. Page 21, lines 1-7 implies that if the amount of compound having an unsaturated bond-containing chain which can undergo hydrogen addition in the electrolyte solution is within the claimed range of 0.1-10 wt%, then the amount on the electrodes and in the separator are within the claimed ranges. Therefore, one of ordinary skill in the art would expect the amount of tetraacetic acid chelates on the electrode and in the separator to be within the claimed ranges since the amount of is within the claimed range. The reference teaches the claimed solutions and capacitors.

Claims 8 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,288,889.

As discussed above, this reference teaches the claimed electrolyte solution. Column 5, lines 52-65 teaches the amount of tetraacetic acid chelates in the solution should be present in an amount of 0.01-3 wt%, which overlaps the claimed amount of compound having an unsaturated bond-containing chain which can undergo hydrogen addition. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re*

Fields 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed electrolyte solution.

Claims 1-3, 7, 9, 12-16, 25, 27, 29 and 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2000-173863.

The translation of this reference teaches an electrolyte comprising an electrolytic solution comprising 80-20 wt% water, 20-80 wt% of a protic and/or aprotic organic solvent, at least one compound selected from the group consisting of chelates, saccharides, a nitro compound, gluconic acids and/or gluconic lactone and hydroxybenzyl alcohols and/or L-glutamic acid diacetate or its salts and fumaric acid or maleic acid, which are unsaturated bond-containing chain which can undergo hydrogen addition compounds having a carbon-carbon π bond and carboxyl groups. The reference teaches the claimed solution and capacitor.

Claims 1-3, 7, 9, 12-22, 25, 27, 29 and 32-38 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 2000/33337.

Claims 1-3, 7, 9, 12-22, 25, 27, 29 and 32-38 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. patent 6,349,028.

U.S. patent 6,349,028 is the English equivalent to WO 2000/3337 and thus is the translation for WO 2000/3337.

These references teach an electrolyte comprising an electrolytic solution comprising 80-20 wt% water, 20-80 wt% of a protic and/or aprotic organic solvent, at least one compound selected from the group consisting of chelates, saccharides, a nitro compound, gluconic acids and/or gluconic lactone and hydroxybenzyl alcohols and/or L-glutamic acid diacetate or its salts and fumaric acid or maleic acid, which are unsaturated bond-containing chain which can undergo

hydrogen addition compounds having a carbon-carbon π bond and carboxyl groups. Since the electrodes and separator are immersed in an electrolyte solution, which is the second process of claims 19 and 22, the fumaric or maleic acid must be on the electrode surface and in the separator, absent any showing to the contrary. The reference teaches the claimed solution and capacitor.

Claims 1-4, 10-15, 25, 26, 29-33 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2000-173872.

The translation of this reference teaches an electrolyte comprising an electrolytic solution comprising 80-20 wt% water, 20-80 wt% of a protic and/or aprotic organic solvent, an electrolyte selected from carboxylic acids and inorganic acids, at least one compound selected from the group consisting of chelates, saccharides, gluconic acids and/or gluconic lactone and hydroxybenzyl alcohols and/or L-glutamic acid diacetate or its salts and one of nitroacetophenone, nitrobenzoate or dinitrobenzoate, which are unsaturated bond-containing chain which can undergo hydrogen addition compounds. The taught carboxylic and inorganic acids include those claimed. The reference teaches the claimed solution and capacitor.

Claims 1-6, 9-15, 17-26, 28-33 and 35-40 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 2000/33338.

Claims 1-6, 9-15, 17-26, 28-33 and 35-40 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 6,285,543.

U.S. patent 6,2,85,543 is the English equivalent to WO 2000/3338 and thus is the translation for WO 2000/3338.

These references teach an electrolyte comprising an electrolytic solution comprising 80-20 wt% water, 20-80 wt% of a protic and/or aprotic organic solvent, an electrolyte selected from carboxylic acids and inorganic acids at least one compound selected from the group consisting of chelates, saccharides, gluconic acids and/or gluconic lactone and hydroxybenzyl alcohols and/or L-glutamic acid diacetate or its salts and nitroacetophenone, nitrobenzoate or dinitrobenzoate which are unsaturated bond-containing chain which can undergo hydrogen addition compounds. The taught carboxylic and inorganic acids include those claimed. Since the electrodes and separator are immersed in an electrolyte solution, which is the second process of claims 19 and 22, the must be nitroacetophenone, nitrobenzoate or dinitrobenzoate on the electrode surface and in the separator, absent any showing to the contrary. The examples teach the amount of carboxylic acid can be present in an amount of 4.6-25 wt% and the amount the amount of inorganic acid is 0.4-1.6 wt% and the amount of nitroacetophenone, nitrobenzoate or dinitrobenzoate can be 1 wt%. These amounts fall within the claimed ranges. Page 21, lines 1-7 implies that if the amount of compound having an unsaturated bond-containing chain which can undergo hydrogen addition in the electrolyte solution is within the claimed range of 0.1-10 wt%, then the amount on the electrodes and in the separator are within the claimed ranges. Therefore, one of ordinary skill in the art would expect the amount of nitroacetophenone, nitrobenzoate or dinitrobenzoate on the electrode and in the separator to be within the claimed ranges since the amount of is within the claimed range. The reference teaches the claimed solution and capacitor.

Claims 8 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2000-173872; WO 2000/3338 and U.S. patent 6,285,543.

As discussed above, this reference teaches the claimed electrolyte solution. Paragraph 0030 in JP 2000-173872 and column 6, lines 45-56 in the U.S. patent teach the amount of in the nitroacetophenone, nitrobenzoate or dinitrobenzoate solution should be present in am amount of 0.01-5 wt%, which overlaps the claimed amount of compound having an unsaturated bond-containing chain which can undergo hydrogen addition. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed electrolyte solution.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 7-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-16 and 21-30 of copending Application No. 10/490,651. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed solution and capacitor suggests the solution and capacitor claimed in this application since Application No. 10/490,651 teaches a

solution having the claimed components and 0.001-5 wt% of aminonitrobenzonitrile, which meets the requirements of claims 7, 16, 27 and 34 and it teaches this compound on the surface of the electrode and in the separator in overlapping amounts of mg/cm^2 .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-3, 7, 9, 12-16, 25, 27, 29 and 32-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,349,028. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented capacitor and solution suggests the claimed solution and capacitor.

Claims 1-4 and 7-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,285,543. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented capacitor and solution suggests the claimed solution and capacitor for the reasons discussed above.

Claims 1-4, 8-15, 17-26, 28-33 and 35-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,288,889. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented capacitor and solution suggests the claimed solution and capacitor for the reasons discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
March 3, 2006

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